

**REMARKS**

The present application relates to inbred maize line PH5W4. Claims 2-57 have been canceled. New claims 58-87 have been added. No new matter has been added by the present amendment. Applicant respectfully requests consideration of the following remarks.

**Detailed Action*****A. Claim and Specification Objections***

Applicant acknowledges the rejections of 35 U.S.C. § 112, second paragraph; the rejection of claim 40 under 35 U.S.C. § 112, first paragraph; and the art rejection under 35 U.S.C. § 102/103, as withdrawn.

The Examiner objects to the Table A comprising SSR data inserted on page 16 of the specification at line 23 under 35 U.S.C. § 132 as new matter. Applicant objects to the Examiner's objection of new matter however in order to expedite prosecution Applicant herein cancels the above-referenced material that had been filed February 28, 2003, thus alleviating this rejection.

***B. Newly Submitted Claims***

Applicant acknowledges the addition of new claims 58 through 87, as specifically stated by the claims faxed by Examiner David Fox on November 15, 2002 and the new sample claim submitted by Supervisory Patent Examiner Amy Nelson via e-mail on August 7, 2003. The new claims do not add new matter as there is support for the claims in the originally filed specification. Support for the specific items noted in the claims faxed by Examiner Fox can be found within the specification for *Bacillus thuringiensis* on page 28; for imidazolinone, sulfonylurea, glyphosate, glufosinate, L-phosphinothricin, triazine, and benzonitrile on pages 31-32; for phytase on page 32; for stearyl-ACP desaturase, fructosyltransferase, levansucrase, alpha-amylase, invertase and starch branching enzyme on pages 32-33; and for waxy starch and increased amylose starch on pages 21 and 33.

**Rejections Under 35 U.S.C. § 112, Second Paragraph**

Claims 51 and 55-57 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claims 51, 55, and dependents thereon, stand indefinite for improper Markush terminology. Although not acceding to the Examiner's rejection, in order to expedite prosecution Applicant has canceled claims 51, 55, and dependents thereon, thereby rendering this rejection moot.

In light of the above amendments and remarks, Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 112, second paragraph.

**Rejections Under 35 U.S.C. § 112, First Paragraph**

Claims 43 and 50-53 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, Applicant had possession of the claimed invention. The Examiner states that claim 43 recites "at least 50% genetic contribution from" and claims 50 and 52 recite "backcross conversion" in which there is no basis in the specification for either term therefore constituting new matter.

Although not acceding to the Examiner's rejection, to expedite prosecution Applicant has canceled claims 43 and 50-53, thereby rendering this rejection moot. Applicant has added new claims 58-87, as specifically stated by the claims faxed by Examiner David Fox on November 15, 2002 and the new sample claim submitted by Supervisory Patent Examiner Amy Nelson via e-mail on August 7, 2003. The new claims do not add new matter as there is support for the claims in the originally filed specification as described *supra*.

Claims 9-10, 15-16, 28-29, 37-39, 41-43 remain rejected and claims 50-54 and 57 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, Applicant had possession of the claimed invention, for the reasons of record stated in the last Office Action on pages 3-5.

Applicant traverses this rejection. Nevertheless, in order to expedite prosecution claims 9-10, 15-16, 28-29, 37-39, 41-43, 50-54 and 57 have been canceled and new claims 58-87 have been added as disclosed *supra*. Applicant requests reconsideration.

Claims 9-10, 15-16, 28-29, 37-39, 41-43 remain rejected and claims 50-54 and 57 stand rejected under 35 U.S.C. § 112, first paragraph as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains

or with which it is most nearly connected, to make and/or use the invention, as stated on pages 6-8 of the last Office Action.

Applicant respectfully traverses this rejection. The Applicant has provided assurance that at least 2500 seeds of inbred maize line PH5W4 have been deposited with the ATCC. In view of this assurance, the rejection under 35 U.S.C. § 112, first paragraph, should be removed. (MPEP § 2411.02). Applicant submits in order to expedite prosecution claims 9-10, 15-16, 28-29, 37-39, 41-43, 50-54 and 57 have been canceled and new claims 58-87 have been added as disclosed *supra*. It is respectfully submitted that Applicants' claims are sufficiently described and enabled by the specification.

In light of the above amendments and remarks, Applicant respectfully requests withdrawal of the rejections to claims 9-10, 15-16, 28-29, 37-39, 41-43, 50-54, and 57 under 35 U.S.C. § 112, first paragraph.

### Summary

Applicant acknowledges that claims 1-2, 4-8, 21, 23-27, and 40 are allowed.

Applicant has amended the claims as suggested by Examiner David Fox and Supervisory Patent Examiner Amy Nelson as allowable. Applicant submits the claims place the application in condition for allowance and comply with all requirements of form set forth in previous office actions.

### Conclusion

In conclusion, Applicant submits in light of the above amendments and remarks, the claims as amended are in a condition for allowance, and reconsideration is respectfully requested. If it is felt that it would aid in prosecution, the Examiner is invited to contact the undersigned at the number indicated to discuss any outstanding issues.

No fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,



Lila A. T. Akrad, Reg. No. 52,550  
McKEE, VOORHEES & SEASE, P.L.C.  
801 Grand Avenue, Suite 3200  
Des Moines, Iowa 50309-2721  
Phone No: (515) 288-3667  
Fax No: (515) 288-1338  
**CUSTOMER NO: 27142**

- bja/mlw -

Attorneys of Record

FAX RECEIVED  
AUG 20 2003  
GROUP 1600

OFFICIAL